UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,222	06/01/2000	Roger Massey	GEMVAL P15AUS	4902

20210 7590 09/20/2002

DAVIS & BUJOLD, P.L.L.C.
500 NORTH COMMERCIAL STREET
FOURTH FLOOR
MANCHESTER, NH 03101

EXAMINER
BONDERER, DAVID A

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 14

Application Number: 09/585,222
Filing Date: June 01, 2000
Appellant(s): MASSEY, ROGER

Scott A. Daniels
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 5, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2 and 3 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,280,526	Gonzalez	6-1981
3,345,032	Rawstron	10-1967
2,309,666	Parker	2-1943
3,417,450	Zell	12-1968

(10) Grounds of Rejection

Claims 1 and 5 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 11.

Claims 1-3 and 5-8 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 11.

(11) Response to Argument

The main contention is that Gonzalez does not teach the eccentric flow passage in a valve that has one side thicker than another. First the Applicant states that Figure 2 is a mistake and Figure 1 is the actual invention of Gonzalez. It is just as easy, in reference to the specification, to assume that the mistake was made in Figure 1 and not Figure 2. The Applicant contends that if this is what Gonzalez disclosed as the invention he would have specifically stated that the side is thicker that the other in the specification.

The examiner obviously disagrees with this contention. The specification is only required to enable one of ordinary skill in the art at the time of the invention to make and use the invention. Every mundane detail does not have to written out to enable an invention. Making one side thicker as disclosed by the drawings is not considered by the examiner to be so difficult that it has to be written out to enable one to make it nor so novel as to make it the focus of the invention. It is clear that one of ordinary skill in the art is taught to make a valve with a thicker portion at the bottom by the drawing. The simple metalworking needed to build such a thing is beneath one of ordinary skill in the art. Even if this information was not intended to be taught, it has been, and has been part of general working knowledge of the art since July 1981.

It is held by the Examiner that the drawing enables one of ordinary skill in the art at the time of the invention to make a bar stock valve with one side thicker than the other. Justification for this holding comes from the fact that if during the prosecution of Gonzalez after the first rejection he were to amend the claims to state that one side of the valve was thicker that the other, the Examiner would be unable to apply a new matter rejection. Even if the Examiner were to hold than the Figure

2 was a mistake in light of Figure 1 and the lack of reference in the specification, the board has held that if an element is made clear by the drawing, it is disclosed and not new matter. Even if the Examiner held that Figure 1 was the correct drawing, the board would have the same holding; the specification does not specify which one is the correct drawing; both are disclosed; and no new matter has been entered.

In the absence of a clear indication of which drawing is correct, the Examiner believes that Figure 2 enables and teaches the public how to make and use a quarter turn ball valve made of bar stock with and eccentric flow passage.

Also, in the absence of any legal authority presented to the Examiner, it is the duty of the Examiner to hold the drawings as enabling and hold the rejection.

In response to the arguments under 103, the examiner contends that the combination of references is proper in view of the above and the following arguments.

Making one side of a structure thicker than another is obvious to one of ordinary skill in the art. Removing material from where it is not needed is also obvious. First lets look at the obvious reasons to make something thicker or thinner. Many times the strength of a structure depends on its thickness. Material is added where one feels that the stresses are going to be great. More material equates to a stronger area. This is a basic engineering principle. In valves, stress is incurred at connections and at valve stems. It is obvious to have thick portions in these areas.

In areas where stresses are not incurred, material can be taken away. The "I" beam is a perfect example of this basic principle. A steel "I" beam is as strong as a sold steel beam of the same dimensions. The section between the top and the bottom of the "I" beam encounter minimal stress therefore the material can be removed and conserved. In the instant invention material is removed and added where needed. In the effort to conserve materials, space, and weight, designing a valve

with dimensions that place material where needed and remove materials where they not is obvious and well within the general knowledge of one with ordinary skill in the art. The obvious methods of reducing the size is done by machining down the bar stock and/or pre-making the bar stock to certain specifications. Zell and Parker render proof of the obviousness as disclosed in Paper 8. In the instant invention the placement of the thickest portion lacks criticality. The arbitrary placement of the thick portion goes to it being an obvious design choice.

The Examiner contends that the making of a two way valve into a three way valve is just a duplication of parts and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Rawstron also teaches this as disclosed in the rejections.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Henry C. Yuen
Supervisory Patent Examiner
Group 3700

dab
September 17, 2002

Conferees
M. Chambers
H. Yuen

A. MICHAEL CHAMBERS
PRIMARY EXAMINER
ART UNIT 3753

DAVIS & BUJOLD, P.L.L.C.
500 NORTH COMMERCIAL STREET
FOURTH FLOOR
MANCHESTER, NH 03101